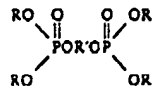
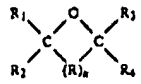
REMARKS

Claim 1 has been amended to so as to include the phosphate formula of claim 2 and the oxetane formula of claim 6. Support for this amendment can be found throughout the specification and in particular in the claims as originally filed. New claim 18 has been added to the application and claims 2 and 6 have been cancelled. Support for claim 18 can be found throughout the specification including pages 2 and 3 and the Examples. No new matter has been added.

In the Office Action, claims 1-9 have been rejected under 35 U.S.C. §112, first paragraph, as allegedly not being enabled by the specification. In particular, making the rejection the Examiner acknowledged that the specification is enabling for the instant composition comprising the phosphate formula of claim 2 and the oxetane formula of claim 6. Although Applicants believe that the claims as originally filed are enabled by the specification, claim 1 has been amended so as to include the phosphate formula of claim 2 and the oxetane formula of claim 6. Accordingly, since the Examiner has already acknowledged that this composition is enabled by the present specification, it is respectfully requested that the rejection of claims 1, 3-4 and 7-9 be withdrawn. Claims 2 and 5-6 have been cancelled and therefore the rejection as it pertains to these claims is now moot.

In the Office Action, claims 1-9 have been rejected under 35 U.S.C. §103(a) as allegedly being obvious over Bright et al. (US 5,041,596 - Examiner has listed the reference as 55,041,596, but according to the Examiner's PTO 1449 the reference is properly listed as 5, 041,596 and it is this reference that the Applicants used when responding to this rejection).

In making the rejection, the Examiner contended "Bright et al. discloses a process for making bisphosphate compounds (i.e. phosphate ester) by reacting pyrophosphate compounds with cyclic ether compounds (i.e. oxetane).... Therefore Bright et al. ***inherently*** discloses a final product, i.e., a composition comprising bisphospahte (sic) compounds (i.e.,  , wherein the variable R represents hydrocarbyl, and the variable R' represents hydrocarbylene), and an oxetane compound (i.e., cyclic ether compound of the formula ). "(See OA, page 9-emphasis added). For the reasons discussed below the Applicants respectfully disagree and therefore traverse the rejection.

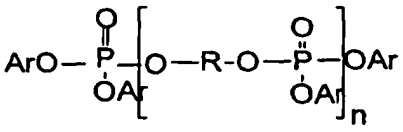
It is well established that in order for the process described in Bright et al. to "inherently disclose a final product" of the present invention it is respectfully pointed out that the inherency must be absolutely certain and not a mere possibility: *In re Oelrich* (CCPA 1981) 666 F.2d 578, 212 USPQ 323; *Ex parte Keith et al.* (POBA 1966) 154 USPQ 320. As was stated in the CCPA decision *Hansgirg v. Kimmer* (CCPA 1939) 102 F.2d 212, 40 USPQ 665 more than 60 years ago:

> Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient [emphasis added].

Furthermore, attention is respectfully called to an article written by Irving N. Feit and Christina L. Warrick entitled "Inherency in Patent Law" in the January 2003 issue of the Journal of the Patent and Trademark Office Society (JPTOS vol. 85, no. 1, January 2003, ppl.5-21). The following dictum is suggested by the authors on page 21 (the last page) of this article:

> The authors believe all of the cases [on inherency] described above, [case citations deleted] can be reconciled. The cases appear to be consistent with the proposition that the ultimate standard for determining whether a claimed element is inherent in the prior art is the objective understanding of a person having ordinary skill in the art [emphasis added].

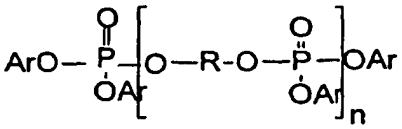
One of ordinary skill in the art would ready understand from reading the Bright et al. reference that a phosphate ester composition of low acidity comprising an oxetane compound according to claim 1 as amended can not be produced from the process described in the reference as contended by the Examiner in making the rejection. That is, a phosphate having the following formula:



where Ar is an aryl or alkaryl group and R is an arylene group as recited in claim 1 as amended can not be made by reacting a pyrophosphate compound with a cyclic ether, namely oxetane, as described in Bright et al. because oxetane is

always aliphatic and therefore the reaction of these two compounds will always produce a phosphate wherein the R group is an alkylene.

In stark contrast, the composition of claim 1 comprises a phosphate having the following formula:

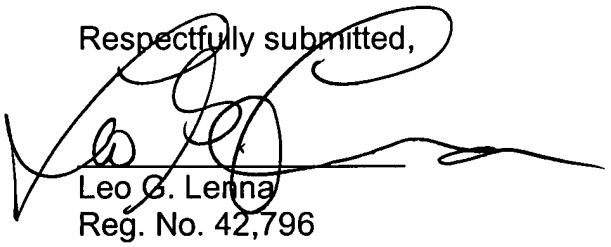


where R is an arylene group *NOT* an alkylene. Since as stated above, an inherent property must be certain, and here it clearly is not since the process in Bright et al. cannot be used to make a phosphate composition of the claim 1 as amended, the composition of claim 1 as amended is neither taught nor suggested by Bright et al. and is certainly not inherent. Accordingly, it is respectfully requested that the rejection of claims 1, 3-4, and 7-9 rejected under 35 U.S.C. §103(a) as allegedly being obvious over Bright et al. be withdrawn. Claims 2, and 5-6 have been cancelled and therefore the rejection as to these claims is now moot.

In view of the above amendments and remarks, it is believed that Claims 1, 3-4,and 7-9 and new claim 18 are in condition for allowance, which is respectfully requested. Since there are no additional rejections made by the Examiner in the present application, early and favorable action is earnestly solicited. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicant's attorney at the number given below.

Favorable action on the merits, and allowance of all claims, is respectfully solicited.

Respectfully submitted,



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